

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

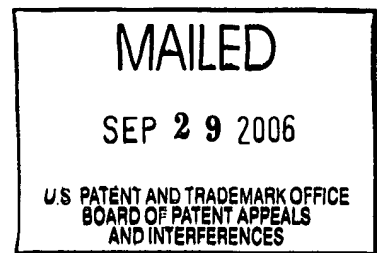
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NATHAN F. RACIBORSKI and MARK R. THOMPSON

Appeal No. 2006-2921
Application No. 09/664,294

ON BRIEF



Before JERRY SMITH, BARRY, and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-21.

The disclosed invention pertains to a self-publishing network directory.

Representative claim 1 is reproduced as follows:

1. A directory for cataloging information on a network, the directory comprising:
 - a first conduit between the directory and a first site;
 - a second conduit between the directory and a second site;
 - a receiver function to accept:
 - a first local catalog of directory information from the first site and
 - a second local catalog of directory information from the second site;
 - a global catalog of directory information that comprises the first local catalog and the second local catalog; and
 - a first timer, wherein the first local catalog is removed from the global catalog if the first site fails to autonomously report in before a first timer expires.

The examiner relies on the following references:

Kraft et al. (Kraft)	6,418,452	Jul. 9, 2002 (filed Nov. 3, 1999)
Tripp et al. (Tripp)	6,516,337	Feb. 4, 2003 (filed Oct. 14, 1999)

The following rejection is on appeal before us:

2. Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tripp in view of Kraft [answer, pages 3-6].

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejection of claims 1-21. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn,

441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

I. We consider first the examiner's rejection of claims 1-7 as being unpatentable over the teachings of Tripp in view of Kraft [answer, pages 3 and 4]. Since appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection. See 37 C.F.R. § 1.37(c)(1)(vii)(2004).

Appellants argue that Tripp and Kraft do not teach nor suggest that a local catalog is removed from a global catalog if the site providing the

catalog fails to autonomously report in before a timer expires [brief, page 4, emphasis added]. With respect to the primary Tripp reference, appellants argue that Tripp's brochure file is not removed upon expiration of a timer associated with a site reporting in, but rather is removed because it is missing from the web site [brief, page 5]. With respect to the secondary Kraft reference, appellants assert that Kraft does not disclose a web site that autonomously reports in [id.]. Appellants point to Kraft, at col. 5, lines 19-22, and assert that Kraft instead teaches a crawler machine that may request file modification information from web servers, [brief, page 6]. Appellants further point to Kraft, at col. 5, lines 41-42, and assert that Kraft merely teaches that registered web servers can report web site modification information to the crawler when requested [id.]. Appellants assert that there is no mention or suggestion in Kraft that the web servers autonomously report in modification information as suggested by the examiner [id.]. Appellants further assert that the examiner has improperly applied the Tripp and Kraft references in a "piecemeal fashion" in formulating the rejection [brief, page 6]

The examiner disagrees [answer, page 7]. The examiner asserts that Tripp's system periodically checks to see if a brochure file is still located at the web site [id.]. The examiner asserts that Tripp teaches removing an entry for the brochure file from the central catalog if the brochure file is not

located at the web site after a certain period of time (Tripp, col. 10, lines 9-15) [id.]. The examiner acknowledges that Tripp does not teach that the web site reports the brochure file as missing [id.]. However, the examiner relies upon Kraft as disclosing a master repository that keeps track of a plurality of web sites where the web sites report to a master server (Kraft, col. 5, lines 41-49) [id.]. The examiner further asserts that Kraft teaches the web server automatically sends registration messages and modification information to one or more repository services, pointing to Kraft at col. 5, lines 29-33, and lines 39-46 [answer, page 8].

At the outset, we note that to reach a proper conclusion under §103, the examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the examiner to ascertain whether the examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in

the claims.” In re Kahn 441 F.3d at 988, 78 USPQ2d at 1337. With respect to the role of the examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” In re Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444.

In the instant case, we agree with appellants that the proffered combination of Tripp and Kraft does not teach nor fairly suggest the claim limitation of: “wherein the first local catalog is removed from a global catalog if the first site fails to autonomously report in before a first timer expires” [claim 1, emphasis added]. In particular, we note that the examiner asserts that Tripp teaches an “implied timer” in disclosing a server that periodically checks the validity of existing brochures at various web sites [see answer, i.e., the rejection of claim 1 at page 3, last line; see also Tripp, col. 10, lines 9-15]. However, we find that the mere mention of the word “periodically” in the Tripp reference does not teach nor fairly suggest the expiration of a timer, per se, as explicitly required by the language of the representative claim [claim 1]. In the alternative, if the examiner is asserting that a timer is inherent in the Tripp reference, we note that the Court of Appeals for the Federal Circuit has determined “ ‘[i]nherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In re Robertson, 169

F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In the instant case, we note that Tripp's server could periodically check the validity of existing brochures according to the day of the week, the day of the month, or in association with any other reoccurring event. Therefore, we find that a timer, and more particularly, the expiration of a timer, as claimed, is not necessarily required for the purpose of defining periodic events.

Furthermore, we agree with appellants that Tripp's brochure file is removed because it is missing from the web site and is not removed upon expiration of a timer associated with a site failing to "autonomously report in," as required by the language of representative claim 1 [see brief, page 5]. We note that this is clearly disclosed by Tripp at col. 10, lines 11-15:

If a brochure is missing and remains missing for a given number of check cycles, the brochure check server 228 sends a request to the brochure database server 226 to delete the entry for the brochure.

We also find that the Kraft reference fails to remedy the deficiencies of Tripp, even though we agree with the examiner that Kraft discloses autonomous reporting. We note that Kraft explicitly discloses: "The repository service software on the web server can automatically send a registration message to one or more master repository service" [Kraft, col. 5, lines 29-32, emphasis added]. Nevertheless, we find that Kraft's disclosure of automatically sending a registration message (i.e., autonomous

reporting) does not meet the language of the claim that requires failing to “autonomously report in” before a timer expires [claim 1].


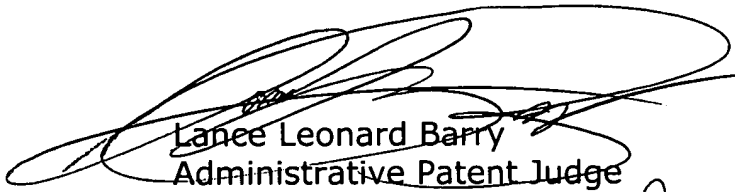
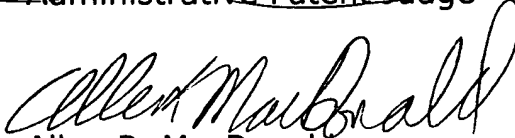
Because the combination of Tripp and Kraft fails to teach or fairly suggest all the limitations recited in the claim, we agree with appellants that the examiner has failed to meet his/her burden of presenting a prima facie case of obviousness. Accordingly, we will reverse the examiner’s obviousness rejection of representative claim 1 as being unpatentable over Tripp in view of Kraft. Because independent claims 8 and 15 recite essentially the same limitation discussed supra with respect to claim 1, we will also reverse the examiner’s obviousness rejection of these claims. Because we have reversed the examiner’s rejection of each independent claim, we will also reverse the examiner’s obviousness rejection of all dependent claims under appeal.

In summary, we will not sustain the examiner’s rejection of any claims under appeal. Therefore, the decision of the examiner rejecting claims 1-21 is reversed.

We leave it to the examiner to consider whether another reference that teaches the expiration of a data timer (e.g., U.S. Pat. 5,511,188 to

Pascucci et al.) could be combined with Tripp and/or Kraft (or other equivalent references) to meet the language of at least the instant independent claims.¹

REVERSED.

)	
Jerry Smith)	
Administrative Patent Judge)	
)	
Lance Leonard Barry)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
Allen R. MacDonald)	
Administrative Patent Judge)	

JS/gw

¹ See U.S. Pat. 5,511,188 at col. 57, lines 14-22 and col. 58, lines 13-21, re: "data aging timer."

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